

REMARKS

Claims 22-29 and 31-33 are currently pending in the above-identified application. Canceled claims 1-15, 27, and 30 were prosecuted in the parent application (USSN 09/418,726), now U.S. Patent 6,331,181. Claims 16-21 were withdrawn as being directed to a non-elected group of claims. Claims 22 and 33 are objected to for informalities and these claims have been amended per the Examiner's request. No new matter has been added by these amendments. The Examiner has also indicated that claims 24, 25, and 29 are allowed.

Restriction Requirement

The Examiner set forth the following restriction in the above-captioned matter:

- I. Claims 16-21, drawn to a method for installing a robotic surgical component, classified in class 128, subclass 898.
- II. Claims 22-32, drawn to a robotic surgical system, classified in class 606, subclass 130.

Applicants note that claim 33 was not included in the Examiner's May 2, 2003 restriction. However, Applicants believe that claim 33 falls within the description of Group II, and Applicants reaffirm their telephone election of Group II, claims 22-33, without traverse.

Claim Rejections under 35 USC §112

Claim 26 is rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that claim 26 lacks antecedent basis for the phrase "the adapter plate."

B

Claim 26 has been amended to delete the term "plate." Because there is antecedent basis for the term "adapter" in claim 25, Applicants believe that claim 26 as currently amended is definite. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 26 as indefinite under 35 U.S.C. § 112, second paragraph.

Claim Rejections under 35 USC §102

Claims 31-33 are rejected under 35 USC §102(b) as being anticipated by Chader *et al.* Applicants respectfully traverse the instant rejection.

It is well-established that in order for a reference to anticipate a claim under 35 U.S.C. § 102(b), the reference must expressly or inherently disclose each and every limitation recited in the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, the reference must disclose the "identical invention ... in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the present case, Chader *et al.* do not disclose each limitation recited in claims 31-33. Chader *et al.* describe an imaging system having a medical instrument and a processor that recognizes the characteristics of the medical instrument and determines the location of the medical instrument based on energy emitted from the instrument. (*See, e.g.*, Abstract; and Figure 5 (step 3).)

In contrast, independent claim 31 requires that the recited processor receive verification information from circuitry of a robotic surgical tool to verify "compatibility of the tool with the robotic surgical system." Similarly, claim 33 requires that the recited robotic surgical tool have "circuitry defining a signal for transmitting to [a] processor so as to indicate compatibility of the tool with [a robotic surgical] system." Verification of "compatibility" of the tool includes verification that the tool is "of the type which is allowable for use on [the] particular robotic surgical system" being used (*see* specification at, for example, page 21, lines 9 and 10). Applicants note that determination of instrument location does not necessarily verify that the instrument is allowable for use on the system used. Further, while Chader *et al.* state

B

that the processor "will be able to recognize the characteristics of the medical instrument ..." (*see* column 6, lines 56-58), the Examiner has not shown where the reference specifically discloses verification of instrument compatibility through such recognition of the instrument's characteristics, nor where the reference discloses how specific characteristics recognized by the processor relate to the instrument's "compatibility" as that term is used in the specification (*see supra*).

Further, the Examiner has not shown where Chader *et al.* disclose (1) a robotic surgical system that is able "to manipulate the tool if the output information [from the tool] matches the predetermined data," as recited in claim 31, nor (2) a robotic surgical tool having circuitry defining a signal comprising "unique tool identifier data" that can be manipulated by a processor "according to a predetermined function so as to derive verification data ...," as recited in claim 33.

Therefore, at least for the reasons set forth above, Chader *et al.* do not anticipate claims 31-33. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the instant rejection of claims 31-33 under 35 USC §102(b).

#### Double Patenting

Claim 28 is rejected under the doctrine of obviousness-type double-patenting as being unpatentable over claim 24 of U.S. Patent 6,331,181 in view of Chader *et al.* Attached hereto is a terminal disclaimer signed by Applicants and which disclaims the terminal portion of any patent issuing from the instant application which extends beyond the expiration date of U.S. Patent 6,331,181.

In view of the above, the Examiner's rejection of claim 28 for obviousness-type double patenting is obviated.

B

MICHAEL J. TIERNEY et al.

PATENT

Application No.:

Page 11

CONCLUSION

Applicants respectfully request reexamination and reconsideration of the application. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Dated: 10/31/03

By: Craig P. Wong  
Craig P. Wong  
Reg. No. 45,231

TOWNSEND and TOWNSEND and CREW, LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, CA 94111  
Telephone: (206) 467-9600  
Tealeaf: (415) 576-0300

B